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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DUNHAM, JASON B

ART UNIT	PAPER NUMBER
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3625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,231	Applicant(s) VON ZIMMERMANN ET AL.	
	Examiner JASON B. DUNHAM	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 16-24 and 28-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 16-24 and 28-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 12, 2009 has been entered. Applicant amended independent claims 1, 10, 24, and 31, added new claims 32-34, and canceled claims 25-27. Claims 1-10, 16-24, and 28-34 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Method claims 1-9, 28, 31, and 32 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In *re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, the claims are non-statutory since they may be performed within the human mind.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al-

[http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=](http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0)

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Apparatus claims 10, 16-23, 29, and 33 are rejected under 35 U.S.C. 101. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-

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58, are not patentable. Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. The claims are merely directed to a computer program per se; see applicant’s specification paragraphs 27-28 disclosing modules as software.

Medium claims 24, 30, and 34 the claimed invention are directed to non-statutory subject matter. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute “descriptive material.” Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as

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Allowable Subject Matter

Claims 32-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and pending resolution of the above noted 35 USC 101 rejections noted above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 16-24, and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flores (US 6,058,413) in view of Scolini (US 2003/0233321).

Referring to claim 1. The combination of Flores and Scolini discloses a method for automatically filing documents relating to business transactions, using a computer system, the method comprising:

- Receiving business data about a business transaction (Flores: abstract);
- Producing at least one input data record from the business data comprising an input header with general data, the input data record having a structure specific to a class of the business transaction (Flores: abstract, figures 4-6, and columns 7, lines 44-61 and column 23 disclosing an input header included in transaction message);

Flores discloses all of the above including adding data from a database application to the output data record (Flores: figure 7 and page 23 disclosing the use of headers to address messages related to business transactions) and storing individual output data with an identification code (column 9, lines 18-29) but does not expressly disclose transforming input into output data formatted for compatibility. Scolini discloses a method of processing transactions including:

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- Transforming the at least one input data record into an output data record, comprising:
 - Generating an output header for the output data record, the output header including the general data from the input header (paragraph 438 disclosing creating an output header with bill payer information);
 - Reading additional data relating to the business transaction, from a database application (paragraphs 1160-1164 disclosing receiving details related to transactions from invoice tables);
 - Adding the additional data to the output header (paragraph 438 disclosing creating an output header with bill payer information);
 - formatting a first data area of the output data record, such that the first data area is compatible with a first business application, and formatting a second data area of the output data record such that the second data area is compatible with a second business application (paragraphs 591-599 disclosing formatting bills for different customers).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Flores, to have included generating output headers and producing different output records for different business applications depending on their data requirements, as taught by Scolini, in order to provide required reports to customers and multiple carriers with a single billing solution (Scolini: abstract).

Referring to claims 2-6. Claims 2-6 are rejected under the same rationale set forth above. The combination of Flores and Scolini discloses a method of producing, transforming, transferring, and storing the records of claim 1 through the use of program modules via an interface (Flores: figures 3-4 and column 7, lines 4-20 and column 8, lines 14-30).

Referring to claim 7. The combination of Flores and Scolini further discloses a method wherein the output data record is stored on a transactional basis (Flores: column 9, lines 18-29).

Referring to claim 8. The combination of Flores and Scolini further discloses a method wherein the output data record includes, for a plurality of business applications, a database structure having one or more tables (Flores: table 2).

Referring to claim 9. The combination of Flores and Scolini further discloses a method wherein the output data record includes, for different journals in accounting, different data areas (Flores: column 3, line 47 – column 4, line 11). The examiner notes that applicant's specification defines journals as tabular summaries of posting records, separated for example into areas regarding costs, storage type and location, and customer. Flores discloses separate database for recording sales price and quantity ordered (Flores: column 9, lines 44-58).

Referring to claims 10 and 16-24. Claims 10 and 16-24 are rejected under the same rationale set forth above. The combination of Flores and Scolini further discloses a system and medium according to claims 10 and 16-24 as evidenced by the cited portions in the rejection of the method claims and column 7, lines 4-20.

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Referring to claim 28. The combination of Flores and Scolini further discloses a method wherein the first and second business applications each assess the business transaction using different business management methods (Scolini: paragraphs 277 disclosing different requirements for various users).

Referring to claims 29-31. Claims 29-31 are rejected under the same rationale set forth above.

Response to Arguments

Applicant's arguments with respect to claims 1-10, 16-24, and 28-31 have been considered but are moot in view of the new ground(s) of rejection. Please note the indication of allowability for dependent claims 32-34 above. The applicant is invited to call the Examiner to discuss any remaining issues and to expedite prosecution.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason Dunham/ 4/10/09